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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,128	06/24/2003	Brian L. Wilt	KMC / 302US	1590

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EXAMINER	
NGUYEN, THONG Q	

ART UNIT	PAPER NUMBER
2872	

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/602,128	WILT ET AL.	
	Examiner	Art Unit	
	Thong Q Nguyen	2872	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 September 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-13* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The present Office action is made in response to the amendment filed on 10 September 2004. It is noted that in the mentioned amendment, applicant has made amendments to the specification, the drawings and the claims.

Drawings

2. The drawings contain one sheet of figures 9-10 in which the figure 10 is corrected was received on 9/10/2004. The corrected sheet of figures 9-10 is accepted by the Examiner.

3. *The objections to the drawings as set forth in the previous Office action are now withdrawn due to the amendments to the specification and the drawings as made by the amendment of 9/10/2004.*

Specification

4. The lengthy specification which is amended by the amendment of 9/10/2004 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

5. The disclosure is objected to because of the following informalities: a) Page 13: line 20, "10b" should be changed to –10a--; b) In Table 1, in column "Sep." the value of the distance/separation between lens elements III and IV is incorrect. Applicant should amend the mentioned value by changing "S_2 = 13.5

9 " to --S_2 = 13.59--; and c) In Table 2, in column "Sep." the value of the distance/separation between lens elements III and IV is incorrect. Applicant should amend the mentioned value by changing

"S_2 = 14.4

6 " to --S_2 = 14.46--

Appropriate correction is required.

It is noted that the objection to the specification as set forth in element a) above was made in the previous Office action. In the amendment of 9/10/04, pages 15-16, applicant has stated that the specification in page 13 is amended to overcome the objection; however, applicant has not made any amendment to page 13 as stated.

6. The amendment filed on 9/10/2004 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. ***The added material which is not supported by the original disclosure is as follows: the maximum diameter of the objective lens as newly-added to Table 1, Table 2, paragraphs 29 and 35.***

Applicant is required to cancel the new matter in the reply to this Office Action.

The specification as originally filed has never disclosed and taught that the values of the diameter of the objective lens as listed in the Tables 1 and 2 are the maximum values of the diameter of the objective lens as recited in the amendment. It is noted that the applicant's arguments provided in the amendment, page 16, last three

lines through page 17, first nine lines have been fully considered but they are not persuasive. Applicant has argued: "that the specifying lens element diameters...manufacture the loop" (amendment, page 17, lines 2-5); however, the applicant has failed to provide at least one written evidence to show a conventional art showing a lens having a non-circular shape wherein the diameters of both sides of the lens having the same maximum value as claimed.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 4-5 and 12-13 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The device as claimed in each of claims 4-5 and 12-13 is rejected under 35 USC 112, first paragraph because the specification as originally filed has not provided a support for the feature related to the maximum values of the diameter of the objective lens as recited in each of the amended claims 4-5 and 12-13. In particular, the original specification has not disclose that the value of the diameter of the objective lens as listed in the table is the maximum value of the diameter of the objective lens as claimed in the amended claims 4-5 and 12-13.

9. Claims 1-11 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

a) Each of claims 1 and 10 recites a magnification loupe having a housing for supporting an eyepiece lens and an objective lens wherein the objective lens having a non-circular shape. However, the data relating to the diameter of the objective lens as provided in the specification does not provide support for the feature claimed. In particular, the table 2, page 11, provide optical data of the lens elements wherein the diameters of the objective lens element IV are the same for both dimension. As a result of data of the lens element IV, it is clear that the objective lens IV does not have a non-circular shape as claimed.

In response to the rejection of the claims under 35 USC 112, first paragraph as set forth in the previous Office action and now repeated in this Office action, applicant has made amendments to the Tables 1 and 2 which provide optical data of the lens element in which the values of the diameter of the objective lens is changed to maximum values of the diameter of the objective lens. However, the change as mentioned has brought new matter to the claim (see the rejection of the claims 4-5 and 12-13 as provided above). The device as claimed without the newly-added material to the specification is maintained rejected for the same reason as set forth in the previous Office action and repeated as above.

b) The remaining claims are dependent upon the rejected base claims and thus inherit the deficiency thereof.

10. Claims 4-5 and 12-13 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a magnification loupe having a single eyepiece lens and a two element objective lens, does not reasonably provide enablement for a magnification loupe having lens elements as claimed. See further details provided below. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

The device as claimed in the set of claims 4 and 12 and the device as claimed in the set of claims 5 and 13 does not have support/enablement in the specification. Applicant is respectfully invited to review the device as disclosed in the specification. In particular, the specification discloses two embodiments of the magnification loupe carried by a user wearable device as follow.

The first embodiment discloses a magnification loupe having a single eyepiece lens and a two-element objective lens wherein the loupe is pivotally connected to a spectacles having a pair of lenses. As shown in pages 7-9 and Table 1, the lens labeled as I is the lens of the spectacles, the lens labeled as II is the eyepiece lens and the lenses labeled as III and IV are the two-element objective lens. As a result, the lens structure as claimed in each of claims 4 and 12 does not matched with the lens structure of the magnification loupe which comprises

only a single eyepiece lens and a two-element objective lens as taught in the specification in pages 7-9 and Table 1.

The second embodiment discloses a magnification loupe having a single eyepiece lens and a two-element objective lens wherein the loupe is mounted through the eyeglass lens element of a spectacles having a pair of lenses. Since the loupe is mounted through the eyeglass lens element of a spectacles; therefore, a correction lens is used. As shown in pages 9-12 and Table 2, the lens labeled as I is the lens of the correction lens, the lens labeled as II is the eyepiece lens and the lenses labeled as III and IV are the two-element objective lens. As a result, the lens structure as claimed in each of claims 5 and 13 does not matched with the lens structure of the magnification loupe which comprises only a single eyepiece lens and a two-element objective lens as taught in the specification in pages 9-12 and Table 2.

In response to the rejections of claims 4-5 and 12-13 as set forth in the previous Office action, applicant has made amendment to each claim and added the feature that the lens element labeled as "I" in each claim is an optical element of the user wearable device. ***However, the optical device as claimed in the Table of each claim is NOT the magnification loupe as claimed****. The optical device as provided by the Table of each claim is a combination of a user wearable device having a (correcting) lens and a magnification loupe having an eyepiece lens and an objective lens.*

Claim Objections

11. Claims 5, and 12-13 are objected to because of the following informalities. Appropriate correction is required.

a) In each of claim 5, on line 14, and claim 13, on line 22, "D1, D2, etc. represent" should be changed to –D_1 and D_2 represent--. The reason of this suggestion is that the there are only D_1 and D_2 in the table disclosed the optical data of the lens elements. See Table in the column "Diameter".

b) In claim 5: in column "Sep.", the term "S" of the lens element II should be changed to –S_1—and the term "S" of the lens element III should be changed to --S_2--. Applicant should note that the claim refers/recited that the distance between lens elements II-IV are labeled as "S1" and "S2" (see last three lines of the claim).

c) In claim 12: in column "Radius", the values of the radius of the lens element 1 are nonsensical. What does applicant means by "00 ". Should "00 " be changed to – --.

Further, in column "Sep." the value of the distance/separation between lens elements III and IV is incorrect. Applicant should amend the mentioned value by changing "S_2 = 14.4

6 " to --S_2 = 14.46--.

d) In claim 13, in column "Maximum Diameter", the data provided for the lens element II are unclear. What does applicant means by "D_1 = 13.00D

$_2$ = 13.25" ?

Claim Rejections - 35 USC § 103

12. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

13. Claims 1 and 8-10, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Wada (of record) in view of Kelman (U.S. Patent No. 4,833,890).

Wada discloses an optical device having a magnification loupe attached to an eyeglass. The device as described in columns 1-4 and shown in figures 1-2 and 4-5 comprises the following components: 1) An eyeglass having a frame (1) supporting a pair of prescription lenses (2) wherein the prescription lenses are able to change for a different set of prescription lenses based on intended use or working distance. It is also noted that the prescription lenses can select from a group of lenses having curved surfaces or non-curved surfaces. See column 2, lines 55-60; and 2) a magnification loupe (10) comprises a pair of monoculars (11) which are removably attached to the eyeglass frame via a mechanism (12). Each of the monoculars (11) comprises a housing (13) having a first end supporting a movable eyepiece lens (15) and a protective element (23) and a second end supporting an objective lens (14) and a protective element (17). The objective lens has a non-circular shape having two oppositely peripheral edges defined by a first radius from a first center, and the remaining two oppositely peripheral edges defined by a second radius extending from a second center not coincident with the first center wherein the second radius has a length different

from the first radius. Regarding to the feature relating to the connection of the magnification loupe to the eyeglass, it is noted that in columns 2-3, Wada discloses the use of a mechanism (12) for coupling the pair of the monoculars to the bridge of the eyeglass frame, and each lens (2) of the eyeglass has a bore for allowing the end of the housing of each monocular go through.

As a result, the optical device as provided by Wada meets all of the features of the device claimed except the feature related to the arcuate shape of the peripheral surfaces of the objective lens element. In other words, while the vertical surfaces of the objective lens provided by Wada have arcuate shape; however, the horizontal surfaces of the objective lens have not arcuate shape as claimed.

However, the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is a reduction in weight (see present specification in page 4, section [0010}. In other words, the change in shape of the lens used in the device does not affect to the performance of the device. Further, the use of a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite

surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. See column 8 and fig. 6. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and shown in figure 1.It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See In re Dailey, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Wada by using an objective lens element having a non-circular shape as suggested by Kelman for the purpose of reducing the weight of the lens.

14. Claims 1-3, 6, 8 and 10, as best as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom (of record) in view of Kelman (U.S. patent No. 4,833,890)

Feinbloom discloses an optical device having a magnification loupe attached to an eyeglass. The device as described in columns 1-3 and shown in figures 1-4 and 6 comprises the following components: 1) an eyeglass having a frame with a bridge (14) supporting a pair of lenses (16). It is noted that each lens of the eyeglass frame as shown in figure 2 has a non-curved surface; and 2) a

magnification device comprises a pair of monoculars (18) which are removably mounted through a corresponding lens of the eyeglass. See figures 1-2.

Each of the monoculars (18) comprises a housing (20) having a first end supporting a single eyepiece lens (III) and a correction lens (22) and a second end supporting a two-element objective lens (I, II). The objective lens has a non-circular shape having two oppositely peripheral edges defined by a first radius from a first center, and the remaining two oppositely peripheral edges each defined by a second radius extending from a second center not coincident with the first center wherein the second radius has a length different from the first radius.

As a result, the optical device as provided by Feinbloom meets all of the features of the device claimed except the feature related to the arcuate shape of the peripheral surfaces of the objective lens element. In other words, while the vertical surfaces of the objective lens provided by Wada have arcuate shape; however, the horizontal surfaces of the objective lens have not arcuate shape as claimed.

However, the use of a non-circular lens element having arcuate shape as claimed is merely that of a preferred embodiment and no critical to the device as claimed. The support for that conclusion is found in the present specification in page 13, section [0038] and figures 4 in which applicant has admitted that a lens of a circular shape is able to use in the applicant's device. The only advantage of the use of a non-circular shape lens in comparison to the use of a circular lens is

a reduction in weight (see present specification in page 4, section [0010}. In other words, the change in shape of the lens used in the device does not affect to the performance of the device. Further, the use of a lens having a non-circular shape including an oval shape or an elliptical shape with having two (horizontal) opposite surface having a first radius of curvature and two (vertical) opposite surfaces having a different second radius of curvature is known to one skilled in the art as can be seen in the lens provided by Kelman. See column 8 and fig. 6. It is also noted that the use of a non-circular shaped lens is an alternative choice in regard to the use of a rectangular shape lens is disclosed by Kelman as he disclose his device having a rectangular lens element in the embodiment described in columns 4-5 and shown in figure 1.It is also noted that it was decided in the Courts that a mere change in shape of an element is generally recognized as being within the level of ordinary skill in the art when the change in shape is not significant to the function of the combination. See In re Dailey, 357 F. 2d 669; 149 USPQ 47 (CCPA 1976). Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the device provided by Feinbloom by using an objective lens element having a non-circular shape as suggested by Kelman for the purpose of reducing the weight of the lens.

15. Claims 7 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feinbloom in view of Kelman as applied to claims 6 and 10 above, and further in view of Caplan et al (of record).

The combined product having a magnification loupe coupling to an eyeglass as provided by Feinbloom and Kelman does not explicitly state that the correction lens is able to replace with other correction lens of different optical characteristics for the purpose of varying a working distance. However, the use of a magnification loupe coupled to an eyeglass frame wherein the housing of the loupe supporting an eyepiece lens and a correction lens which lenses are able to replace with different set of eyepiece lens and correction lens for the purpose of varying working distances is known to one skilled in the art as can be seen in the through the lens binocular viewer provided by Caplan et al. See columns 4-5 and fig. 3. Thus, it would have been obvious to one skilled in the art at the time the invention was made to modify the optical device provided by Feinbloom and Kelman by changing the correction lens whenever an eyepiece lens is changed as suggested by Caplan for the purpose for adjusting the working distances as well as the contrast.

Conclusion

16. The additional references are cited as of interest in that each discloses an optical device having lens element wherein the lens element has an oval or elliptical shape.

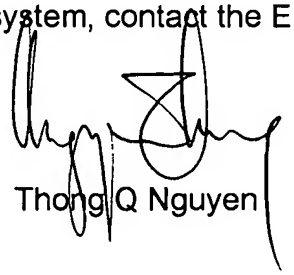
17. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Q Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew A Dunn can be reached on (571) 272-2312. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Thong Q Nguyen

Primary Examiner
Art Unit 2872

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